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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,165	11/12/2003	Ryan F. West	1009-US	7564
7590	07/26/2005		EXAMINER	
MICHAEL A. GUTH 2-2905 EAST CLIFF DRIVE SANTA CRUZ, CA 95062			TOY, ALEX B	
			ART UNIT	PAPER NUMBER
			3739	
			DATE MAILED: 07/26/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/706,165	WEST, RYAN F.
	<b>Examiner</b>	<b>Art Unit</b>
	Alex B. Toy	3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 12 November 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-23 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-23 is/are rejected.

7)  Claim(s) 14 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_ .

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Specification***

The use of the trademark VELCRO has been noted in this application (page 8 paragraph 41). It should be capitalized wherever it appears and be accompanied by the generic terminology. In this case, VELCRO must be described generically as "hook and loop fasteners." Appropriate correction is required.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Objections***

Claim 14 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 4. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-12, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites "said thermal package," however, claim 4 does not distinctly claim a thermal package. It only claims an "indentation (that) is adapted to allow for the placement of a thermal package substantially therein." It is not until claim 10 that a thermal package is specifically claimed. Therefore, it is unclear whether the spinal rest, the thermal package, or the combination of the two is being claimed as the invention. For the purposes of examination, it is assumed that the thermal package is positively recited.

Claim 11, from which claim 12 depends, recites the limitation "said first surface" in the last line of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 1, from which claim 11 depends, recites "a front surface" and "a back surface" but not a "first surface." Therefore, it is unclear from claim 11 whether the boundary between said first layer and second layer is relatively parallel to the front surface or the back surface. For the purposes of examination, it is assumed that "said first surface" refers to the "front surface" of claim 1.

Claim 22 recites the limitation "said second portion" in the second line of the second paragraph of the claim. There is insufficient antecedent basis for this limitation

in the claim. The first line of the second paragraph recites "a second attachment portion" but not a "second portion." Therefore, the meaning of "said second portion" is unclear and indefinite. If it is assumed that "said second portion" refers to said "second attachment portion," then the second clause of paragraph two becomes a redundant duplicate of the first clause of paragraph two. For the purposes of examination, it is assumed that the single clause, "a second attachment portion fastened to the exterior of said second cover," alone is the intended meaning.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 13-17, and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Sullivan (U.S. Pat. No. 5,367,731).

Regarding claim 1, O'Sullivan discloses a therapeutic pillow usable as a spinal rest with a main body portion 120 comprising:

one or more layers of material 144 and 130 (Fig. 15);  
a front surface 124 (Fig. 11);  
a back surface 126 (Fig. 12);

wherein said front surface has an indentation 122 in said front surface (Figs. 11 and 15).

Regarding claim 2, O'Sullivan discloses a therapeutic pillow in accordance with claim 1 whose main body portion 120 further comprises a bottom surface 126 (Fig. 12).

Regarding claim 3, O'Sullivan discloses a therapeutic pillow in accordance with claim 1, wherein said indentation 122 resides fully within the periphery of said front surface 124 (Fig. 11).

Regarding claim 4, O'Sullivan discloses a therapeutic pillow in accordance with claim 1, wherein said indentation 122 is adapted to allow for the placement of a thermal package substantially therein. In the prosecution of this application, "adapted to" is interpreted to mean "capable of." O'Sullivan specifies an insert 28 that could be a thermal package which is capable of fitting inside the indentation 122 (col. 3, ln. 25-26 and Fig. 4).

Regarding claim 5, O'Sullivan discloses a therapeutic pillow in accordance with claim 1, wherein said front surface is contoured to provide lumbar support. Since claim 5 is broad and does not detail a specific front surface contour that is necessary to provide lumbar support, the front surface contour of O'Sullivan is inherently capable of providing lumbar support.

Regarding claim 6, O'Sullivan discloses a therapeutic pillow in accordance with claim 1, wherein said front surface is contoured to provide thoracic support. Since claim 6 is broad and does not detail a specific front surface contour that is necessary to provide thoracic support, the front surface contour of O'Sullivan is inherently capable of providing thoracic support.

Regarding claim 7, O'Sullivan discloses a therapeutic pillow in accordance with claims 1 and 5, wherein said back surface 126 is adapted to be placed substantially in

contact with a seat backrest. The pillow of O'Sullivan is capable of being placed substantially in contact with a seat backrest to provide lumbar support.

Regarding claim 8, O'Sullivan discloses a therapeutic pillow in accordance with claims 1 and 6, wherein said back surface 126 is adapted to be placed substantially in contact with a seat backrest. The pillow of O'Sullivan is capable of being placed substantially in contact with a seat backrest to provide thoracic support.

Regarding claim 9, O'Sullivan discloses a therapeutic pillow in accordance with claims 1 and 4, wherein a thermal package 26 is substantially rectangular (col. 3, ln. 55 and Fig. 1).

Regarding claim 10, O'Sullivan discloses a therapeutic pillow in accordance with claims 1 and 4, comprising a thermal package 26 (col. 3, ln. 55 and Fig. 1).

Regarding claim 11, O'Sullivan discloses a therapeutic pillow in accordance with claim 1, wherein said main body portion 120 comprises a first layer 144 and a second layer 130, wherein the boundary between said first layer 144 and second layer 130 is relatively parallel to the front surface 124 (Fig. 15).

Regarding claim 13, O'Sullivan discloses a therapeutic pillow in accordance with claims 1 and 5, wherein said indentation 122 is adapted to allow for the placement of a thermal package substantially therein. O'Sullivan specifies an insert 28 that could be a thermal package which is capable of fitting inside the indentation 122 (col. 3, ln. 25-26 and Fig. 4).

Regarding claim 14 (a duplicate of claim 4), O'Sullivan discloses a therapeutic pillow in accordance with claim 1, wherein said indentation 122 is adapted to allow for

the placement of a thermal package substantially therein. O'Sullivan specifies an insert 28 that could be a thermal package which is capable of fitting inside the indentation 122 (col. 3, ln. 25-26 and Fig. 4).

Regarding claim 15, O'Sullivan discloses a therapeutic pillow in accordance with claims 1 and 4 comprising a first cover 300 substantially in the shape of the outside surfaces of the main body (col. 4, ln. 40-44 and Fig. 3).

Regarding claim 16, O'Sullivan discloses a therapeutic pillow in accordance with claims 1, 4, and 15, wherein said first cover 300 substantially covers said outside surfaces of said main body (col. 4, ln. 40-42 and Fig. 4).

Regarding claim 17, O'Sullivan discloses a therapeutic pillow in accordance with claims 1, 4, 15, and 16 further comprising a second cover 16 adapted to cover a thermal unit 26 (Fig. 8). Compartment 14 is also capable of being used to cover a thermal unit and is sized to fit substantially within said indentation (Figs. 4 and 8).

Regarding claim 20, O'Sullivan discloses a therapeutic pillow in accordance with claims 1, 4, 15, 16, and 17 further comprising a thermal unit 26, wherein said thermal unit is substantially within said second cover 16 (Fig. 4).

Regarding claim 21, O'Sullivan discloses a therapeutic pillow in accordance with claims 1, 4, 15, and 16 further comprising a first attachment portion 52 fastened to the exterior of said first cover 100, wherein said first attachment portion is fastened to the exterior of said first cover substantially in the region wherein said first cover overlies said indentation (Fig. 8).

Regarding claim 22, O'Sullivan discloses a therapeutic pillow in accordance with claims 1, 4, 15, 16, and 17 further comprising:

a first attachment portion 52 fastened to the exterior of said first cover 100, wherein said first attachment portion is fastened to the exterior of said first cover substantially in the region wherein said first cover overlies said indentation (Fig. 8); and a second attachment portion 52 fastened to the exterior of said second cover 14, said first attachment portion and said second attachment portion disposed such that said first attachment portion and said second attachment portion fasten to each other while positioning said second cover substantially in the region wherein said first cover overlies said indentation (col. 4, ln. 53-59, and Figs. 4 and 8).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Sullivan in view of Contreras (U.S. Pat. No. 5,797,154).

Regarding claim 12, O'Sullivan teaches a therapeutic pillow in accordance with claims 1 and 11 wherein one of said first layer 144 and said second layer 130 is pillow fill (Fig. 8). The claim differs from O'Sullivan in calling for the material to be open cell foam. Contreras, however, discloses a pillow made of open cell foam (col. 3, ln. 14-17 and Figs. 1 and 2) because of its comfort (col. 3, ln. 22). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the pillow of O'Sullivan to be made of open cell foam in view of the teachings of Contreras to make the pillow comfortable. In addition, Contreras cites that there are "various cushioning materials known to those of skill in the art" (col. 3, ln. 14-15). Therefore, it would have been obvious to have made the pillow of O'Sullivan out of several different types of material, one of which is open cell foam.

Claims 18 and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Adat, et al. (U.S. Pat. No. 6,490,743 B1).

Regarding claim 18, O'Sullivan discloses a therapeutic pillow in accordance with claims 1, 4, and 15 with a first cover, but O'Sullivan is silent on the material of said first cover. The claim differs from O'Sullivan in calling for the material to be cloth. Adat, et al., however, disclose an orthopedic pillow cover that is made of a cloth such as cotton or polyester because it is washable and resilient (col. 3, ln. 30-33 and Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the first cover of O'Sullivan to be made of cloth in view of Adat, et

al. because cloth is washable and resilient. In addition, it is well known that cloth is commonly used to make pillow or backrest covers.

Regarding claim 19, O'Sullivan discloses a therapeutic pillow in accordance with claims 1, 4, 15, and 16 with a first cover, but O'Sullivan is silent on the material of said first cover. The claim differs from O'Sullivan in calling for the material to be cloth. Adat, et al., however, disclose an orthopedic pillow cover that is made of a cloth such as cotton or polyester because it is washable and resilient (col. 3, ln. 30-33 and Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the first cover of O'Sullivan to be made of cloth in view of Adat, et al. because cloth is washable and resilient. In addition, it is well known that cloth is commonly used to make pillow or backrest covers.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Sullivan.

O'Sullivan discloses a therapeutic pillow in accordance with claim 1 with an indentation 122 (Figs. 11 and 15). O'Sullivan, however, does not expressly disclose that the approximate dimensions of the indentation are 9.5 inches square and 0.75 inches deep.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make the dimensions of the indentation approximately 9.5 inches square and approximately 0.75 inches deep because Applicant has not disclosed that making the dimensions of the indentation

approximately 9.5 inches square and approximately 0.75 inches deep provides an advantage, is used in a particular purpose, or solves a stated problem.

One of ordinary skill in the art, furthermore, would have expected O'Sullivan's invention to perform equally well with either the approximate dimensions shown in his figures or the claimed approximately 9.5 inches square and approximately 0.75 inches deep because both dimensions can perform the same function of supporting a human neck and head. In addition, O'Sullivan's pillow could be designed for different body sizes, ranging from a large adult to a small child.

Therefore, it would have been an obvious matter of design choice to modify the pillow of O'Sullivan to obtain the invention as specified in claim 23.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Pat. No. D282,427 S to O'Sullivan  
U.S. Pat. No. 5,168,590 to O'Sullivan  
U.S. Pat. No. 4,597,386 to Goldstein  
U.S. Pat. No. 5,363,524 to Lang  
U.S. Pat. No. 5,948,013 to Swezey, et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex B. Toy whose telephone number is (571) 272-1953. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AT AT  
7/21/05

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PRIMARY EXAMINER